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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,398	11/14/2000	Scott C. Harris	BIODONGLE/SCH	8991
23844	7590	01/06/2006	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			MAHMOUDI, HASSAN	
			ART UNIT	PAPER NUMBER
			2165	
DATE MAILED: 01/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/712,398	<b>Applicant(s)</b> HARRIS, SCOTT C.	
	<b>Examiner</b> Tony Mahmoudi	<b>Art Unit</b> 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-14 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-7 is/are allowed.
- 6) ☒ Claim(s) 8-13 and 21 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Remarks***


1. In view of the Appeal Brief filed on 24-October-2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

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2. Claims 3-14 and 21 are presently pending in the application, of which, claims 3, 7, and 8 are presented in independent form.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "instructions as in claim 19" in line 1. There is insufficient antecedent basis for this limitation in the claim, since claim 19 has been cancelled per applicant's request. Appropriate correction is required.

Claim 21 further recites the limitation "the specified way" in line 1, and recites the limitation "said program" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody (U.S. Publication No. 2001/0051928) in view of Borza (U.S. Patent No. 6,721,891.)

As to claim 8, Brody teaches a method (see Abstract), comprising:

requesting a computer system to install a specified computer program (see figure 3, and see paragraphs 0063 and 0082);

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determining whether the computer program is verified for installation (see paragraph 0023);

obtaining a reference biometric information from an authorized user (see paragraph 0094); and

thereafter allowing the program to run normally only when biometric information is obtained which matches the reference biometric information (see paragraph 0153.)

Brody does not teach: obtaining a reference biometric information from an authorized user at the time of installing the software, responsive to the determining that the computer program is verified for installation.

Borza teaches a method of distributing piracy protected computer software (see Abstract), in which he teaches obtaining a reference biometric information from an authorized user at the time of installing the software, responsive to the determining that the computer program is verified for installation (see figures 3a and 3b; see column 7, lines 43-59, where “obtaining a reference biometric information” is read on “the user is prompted for fingerprint information”; also see column 10, lines 40-67.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Brody by the teaching of Borza, because obtaining a reference biometric information from an authorized user at the time of installing the software, responsive to the determining that the computer program is verified for installation, “protects a software application from piracy and increases user convenience by prompting only once for biometric information but it allows execution of the software application to any user in possession of the smart card” (Borza, column 10, lines 43-47); also,

“[p]rompting the user several times during execution of a software application creates user inconvenience but may be desirable, for example in computer networks, to prevent unauthorised use of a software application on a workstation within the network. When user authorisation information in the form of biometric information is to be provided frequently, transparent biometric data collection, i.e. the user is identified by collecting biometric information such as voice recognition, facial recognition, keystroke intervals etc., avoids the inconvenience of a plurality of pauses in software application execution and prompts during the pauses which increase user convenience”, as taught by Borza, (column 10, lines 55-67.)

As to claim 9, Brody as modified, teaches the determining comprises determining if a specified license used for the installation has already been used for another installation (see Brody, paragraphs 0023, and 0058-0060.)

As to claim 10, Brody as modified, teaches wherein the determining uses a specified unique code that was distributed with the program, and determines from a server whether the unique code has already been used for an installation (see Brody, paragraphs 0010, 0015, 0019, and 183.)

As to claim 11, Brody as modified, teaches the method further comprising, after determining that the installation is authorized, sending the reference biometric information to a server (see Brody, paragraph 0098.)

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As to claim 12, Brody as modified, teaches the method further comprising, at the server, encrypting the reference biometric information (see Brody, paragraph 0152), and returning encrypted biometric reference information which is stored with the program, and which is used by the allowing (see Brody, page 23, claim 9, where “biometric reference information” is read on “personalization” and “stored within the program” is read on “within the information stream”).)

As to claim 13, Brody as modified, teaches wherein the allowing retrieves encrypted biometric information (see page 23, claim 9), decrypts the biometric information (see Brody, paragraph 152), and allows the program to run normally only if the decrypted biometric information matches a currently entered biometric information (see Brody, paragraph 0153.)

***Allowable Subject Matter***

7. Claims 3-7 are allowed over the prior art made of record.
8. The following is a statement of reasons for the indication of allowable subject matter:

The appellants' arguments made in the Appeal Brief filed on 24-October-2005 regarding independent claims 3 and 7 have been fully considered and are found persuasive. The prior art made of record does not teach or suggest “allowing the software to run in a limited exception mode without establishing that said personal information agrees with said decrypted information”. Claims 4-6 are allowed they depend from the allowed independent claim 3.

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9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's arguments filed with the Appeal Brief on 24-October-2005, with respect to the rejected claims in view of the cited references have been fully considered but they are moot in view of the new grounds for rejection.

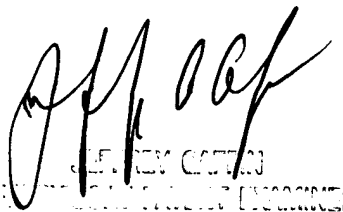
***Conclusion***

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

tm

January 4, 2006

  
JEFFREY GAFFIN  
SUPERVISOR  
ART UNIT 2165  
(571) 272-4146